

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WIZ, INC.
Petitioner,

v.

ORCA SECURITY LTD,
Patent Owner.

IPR2024-00220
Patent 11,431,735 B2

Before RICHARD M. LEOVITZ, DANIEL J. GALLIGAN, and
GARTH D. BAER, *Administrative Patent Judges*.

LEOVITZ, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Wiz, Inc. filed a petition for *inter partes* review of claims 1–7, 9–17, and 19 (“the challenged claims”) of U.S. Patent No. 11,431,735 B2 (Ex. 1001, “the ’735 patent”). Paper 2. Orca Security Ltd. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”).

For the reasons discussed below, we do not institute an *inter partes* review of any challenged claim.

II. DISCUSSION

Patent Owner argues that the Petition is moot and an IPR cannot be instituted because a statutory disclaimer was filed with the U.S. Patent and Trademark Office disclaiming all challenged claims 1–7, 9–17, and 19 of the ’735 patent. Prelim. Resp. 1; *see also* Ex. 2001 (Disclaimer in Patent under 37 C.F.R. § 1.321(a), Form PTO/SB/43 (11-23), filed Apr. 17, 2024).

Under 37 C.F.R. § 42.107(e), “[t]he patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent,” and “[n]o *inter partes* review will be instituted based on disclaimed claims.”

A statutory disclaimer is “considered as part of the original patent” as of the date on which it is “recorded” in the Office. 35 U.S.C. § 253(a). “A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent.” *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996). *See also Raytheon Technologies Corporation v. General Electric Company*, 993 F.3d 1374, n.4 (Fed. Cir. 2021) (“Disclaimed claims are treated as if they never existed.”)

For a disclaimer to be “recorded” in the Office, the document filed by the patent owner must:

- (1) Be signed by the patentee, or an attorney or agent of record;
- (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
- (3) State the present extent of patentee’s ownership interest in the patent; and
- (4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).

37 C.F.R. § 1.321(a). “[N]othing in the statutes or regulations requires any action by the [Patent Office] for a disclaimer to be ‘recorded.’” *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998).

From our review of Exhibit 2001 and the Office’s public records, we conclude that a disclaimer of claims 1–7, 9–17, and 19 of the ’735 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of April 17, 2024. Ex. 2001. Because the Board cannot institute trial on disclaimed claims and all of the challenged claims have been disclaimed here, no *inter partes* review will be instituted. *See Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential) (denying institution of *inter partes* review under rule 37 C.F.R. § 42.107(e) based on disclaimer).

III. ORDER

In consideration of the foregoing, it is hereby ORDERED that pursuant to 35 U.S.C. § 314(a), no *inter partes* review of the challenged claims of U.S. Patent No. 11,431,735 B2 is instituted.

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